

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 600204528-9

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Yaacov Almog

Confirmation No.:

Application No.: 10/763,625

Examiner: Lawrence D Ferguson

Filing Date: 1/22/2004

Group Art Unit: 1774

Title: Coating System for Substrates

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Mall Stop
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

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TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- () Response/Amendment () Petition to extend time to respond
(x) New fee as calculated below () Supplemental Declaration
() No additional fee
(x) Other: Petition to Rescind Examiner's Restriction Requirement (fee \$ 130.00)

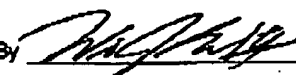
CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		=	X 50	\$
INDEP. CLAIMS		MINUS		=	X 200	\$
I FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+	\$
EXTENSION FEE	1ST MONTH	2ND MONTH	3RD MONTH	4TH MONTH		\$
OTHER FEES						\$ 130.00
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 130.00

Charge \$ 130.00 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

(x) I hereby certify that this paper is being transmitted
to the Patent and Trademark Office facsimile
number (571) 273-8300 on 09/15/2005
Number of pages: 5

Typed Name: LeAnn M. Sassman

Signature: By 

William J. Breen, III

Attorney/Agent for Applicant(s)
Reg. No. 45,313

Date: 09/15/2005

Telephone No.: (509) 324-8256

Rev 12/04 (TransFax)

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Serial No. 10/763,625
Art Unit 1774**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Yaacov ALMOG, et al.
Serial Number: 10/763,625
Filed: January 22, 2004
For: Coating System for Substrates
Art Unit: 1774
Examiner: Lawrence D. Ferguson

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Mail Stop Petition
Honorable Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO RESCIND EXAMINER'S RESTRICTION REQUIREMENT

Sir:

Pursuant to the provisions of 37 CFR §§1.144 and 1.181, Applicant hereby petitions the Commissioner to rescind the Examiner's Restriction Requirement dated September 23, 2004 and final determination of a Restriction Requirement dated June 15, 2005. This Petition is made necessary by the Examiner's apparent failure to consider the facts of this case, the laws and regulations of the United States and the Applicant's previous request for reconsideration.

Applicant respectfully requests that this Petition be handled in an **URGENT** manner. Depending on the disposition of this Petition, Applicant and Examiner may be responsible for fully prosecuting withdrawn claims 31-37 of the originally filed application which have not yet been considered or searched by the Examiner.

The Restriction Requirement

In the Examiner's First Office Action, dated September 23, 2004, the Examiner indicated that the Applicants' application was divided into two distinct inventive groups: Group 1 (claims 1-30), which was drawn to a substrate and Group 2 (claims 31-37), which was drawn to methods of producing and using the substrate of Group 1. Applicants' responded by electing Group 1, claims 1-30, with traverse and a request for reconsideration. On June 15, 2005, the Examiner reiterated

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his Restriction Requirement, refuting Applicants' traversing argument and denying the request for reconsideration.

The basis of Examiner's restriction requirement stems from the language of claim 31 which states that a substrate is produced by overcoating a printing media with an overlayer coating. Examiner proposes that the substrate of claims 1-30 could alternatively be produced by overcoating a printing media with an extruded overlayer coating. Applicant previously responded to Examiner explaining that "overcoating" as used by Applicants is a broad term, and that "overcoating" includes overcoating with an extruded overlayer coating.

Argument Against Examiner's Restriction Requirement

Applicants believe that the Examiner has failed to properly require a restriction for at least two reasons. First, the Examiner has not adequately shown that the product (claims 1-30) and the process for making the product (claims 31-32) are distinct. Further, the Examiner improperly grouped claims for making the product (claims 31-32) with claims for using the product (claims 33-37), even though the test for determining distinctness is different and the Examiner failed to provide an example with regards to using the product, as required by MPEP §806.05(h). Finally, Applicants believe that no serious burden will be imposed on the Examiner by rescinding the improper Restriction Requirement.

According to MPEP §806.05(f), a process of making and product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; or (B) that the product as claimed can be made by another and materially different process. In the current case, the Examiner has chosen to apply (B) by stating that "the product can be made by providing a printing media and overcoating the media with an extruded overlayer coating." In other words, that a materially different process is used to make the product. Applicant disagrees with the Examiner that this a materially different process as the acts as defined in the method claim are the same no matter what the process used to form the coating. First, a printing media is provided and second, it is overcoated. The exact method of overcoating is not defined.

As further evidence of this, Examiner could not avoid describing his alternative method without using Applicants' term "overcoating". Applicants submit that because the Examiner's proposed "alternative" process for making the claimed product is actually identical to the

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Applicants' claimed method, the Examiner has failed to show that the product and process for making the product are distinct.

In addition, Applicants believe that the Examiner improperly grouped claims 31-32 with claims 33-37. As described herein, claims 31-32 are directed towards a process for *making* the claimed product of claims 1-30. However, claims 33-37 are directed towards a process for *using* the claimed product. Applicants do not understand why the appropriate test for distinctiveness, as set forth in MPEP §806.05(h), was not applied by the Examiner to claims 33-37. Furthermore, no example was provided by the Examiner showing that either (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process. This is a burden imposed on the Examiner by MPEP §806.05(h) which was not met. Applicants believe that at the very least, claims 33-37 should be included in Group 1 as the Examiner has failed to properly put forth a Restriction Requirement, in accordance with the rules and regulations of the U.S. Patent and Trademark Office.

As a practical, common-sense matter, Applicants understand that the Examiner is trying to avoid having to search disparate fields of art. However, Applicants feel strongly that a search for the product of claims 1-30 will likely result in the finding of relevant references pertaining to the use and manufacture of that product. The best example Applicants can give is that the reference cited in the Examiner's most recent Office Action, EP 0458481, includes both a process of making the product (see page 2, lines 21-27, and elsewhere) and suggestion of how the product is to be used (see page 2, lines 8-11). Therefore, as a practical matter, it is unlikely the Examiner will experience a serious burden searching for all of the Applicants' claims.

Based on the foregoing argument, Applicants believe that the Examiner has improperly forced a Restriction Requirement in this case. First, the Examiner has failed to show that the product and the process for making the product are distinct inventions. Second, the Examiner grouped the process for making the product and the process for using the product into the same group, without making the proper showing for restricting out the process for using the product. Finally, no serious burden will be imposed on the Examiner by including the three claim sets as all three are likely to appear in a reference uncovered in a patentability search for the product.

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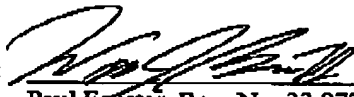
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Applicants request that the Commissioner rescind the Restriction Requirement and allow all pending claims 1-37 to move forward in application serial number 10/763,625.

Respectfully submitted,

Y. ALMOG, et al.

Dated: 9/15/5

By:  Reg. No. 45,313
Paul Fenster, Reg. No. 33,877